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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/955,572	10/22/97	KWON	B IND4-DI1B

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HM11/0424

EXAMINER

KAUFMAN, C

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 04/24/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/955,572

Applicant(s)

Kwon

Examiner
Claire M. Kaufman

Group Art Unit
1646



☒ Responsive to communication(s) filed on Oct 22, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 5, 6, 19-21, and 24-26 is/are pending in the application.

Of the above, claim(s) 19 and 20 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5, 6, 21, and 24-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 5, 6, 19-21, and 24-26 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1812

DETAILED ACTION

1. The preliminary amendment filed 10/22/97 has been entered.
2. This is a file wrapper continuation (FWC) of Applicant's earlier application, serial number 08/461,652 filed under 37 CFR 1.62, and is not a divisional application. Therefore, prosecution continues from the parent application. Furthermore, copies of any prior art that was cited and/or relied upon in the parent application will not be resubmitted to Applicant.
3. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.

Election/Restriction

4. This is a File Wrapper Continuation (FWC) of Applicants' earlier application 08/461,652, filed under 37 CFR 1.62; and is not a divisional application. Therefore, prosecution continues from the parent application, wherein this Office action is directed to the merits of the invention elected in the parent application, *i.e.*, Group I, claims 5, 6, 21, and 24-26. The election was made with traverse in Paper number 4; and was made final in the parent application in Paper number 7.

Priority

5. Applicant's claim for priority is acknowledged. However, the parent applications 07/922,996 and 08/012,269 did not provide adequate support under 35 U.S.C. 112 for claims 5, 6, 21, 22, or 24-26 of this application for the reasons set forth in the previous Office action (paper #10 in section 3. For those reasons, the parent application prior to 08/461,652 is not enabling for H4-1BB or fragments thereof.

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Sequence in Claims

6. 37 CFR 1.821(d) requires the use of an assigned sequence identifier in all instances where the description or claims of a patent application discuss a sequence regardless of whether a given sequence is also embedded in the text of the description or claims of an application. See MPEP 2422.03. The sequence shown in Claim 21 does not constitute new matter because it is shown in SEQ ID NO:2 in the paper copy of the "Sequence Listing". The amino acids shown in claim 21 can be identified in one of two ways: First, the claim can be amended so that a phrase to the effect of "amino acid positions 24-35 of SEQ ID NO:2" is added to the claim; or a unique sequence identifier may be assigned to that peptide and substitute copy of the CRF and paper "Sequence Listing" may be submitted with a statement declaring that no new matter has been introduced by the new sequence and that the CRF and paper copies are the same.

Sequences Presented in Drawing Figures

7. 37 CFR 1.821(b) requires exclusive conformance, with regard to the manner in which the nucleotide and / or amino acid sequences are presented and described, with the sequence rules for all applications that include nucleotide and amino acid sequences that fall within the definitions. When a sequence is presented in a drawing, regardless of the format or the manner of presentation of that sequence in the drawing, the sequence must still be included in the Sequence Listing and the sequence identifier ("SEQ ID NO:X") must be used, either, in the drawing or in the Brief Description of the Drawings. (See MPEP 2422.02.) Figure 1 of the current application, which represents the 4-1BB sequence must reference a sequence identifier and be included in the Sequence Listing and CRF.

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8. ***Claim Rejections - 35 USC § 112, First Paragraph***

Claims 21, 24, and 25-26 remain rejected under 35 U.S.C. 112, first paragraph, for the reason of record set forth in the previous Office action (paper #10) in the first paragraph of section 5.

Claim 5 remains rejected under 35 U.S.C. 112, first paragraph, for the reason of record in the previous Office action (paper #10) in the second paragraph of section 5.

Claim 21 remains rejected under 35 U.S.C. 112, first paragraph, for the reason of record in the previous Office action (paper #10) in the third paragraph of section 5.

Claims 22 and 24 remain rejected under 35 U.S.C. 112, first paragraph, for the reason of record in the previous Office action (paper #10) in the fourth paragraph of section 5.

Claims 25 and 26 remain rejected under 35 U.S.C. 112, first paragraph, for the reason of record in the previous Office action (paper #10) in the fifth paragraph of section 5.

Claim Rejections - 35 USC § 103

9. Claims 5, 6, 21, 22, and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Schwarz et al. (U) in view of Ayala et al. (V) for the reason of record in the previous Office action (paper #10), section 6.

Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goodwin et al. (B) teach the human 4-1BB cDNA and the encoded amino acid sequence (Example 2), as well as soluble human 4-1BB comprising the extracellular domain of the polypeptide (Example 3). This reference is cumulative with the references used above.

Conclusion

11. This is a FWC of applicant's earlier Application No. 08/461,652. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the

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grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Walsh, can be reached at (703) 308-2957.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED** so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



cmk

April 16, 1998


STEPHEN WALSH
SUPERVISORY PATENT EXAMINER
GROUP 1800